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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,813	08/19/2003	Vipul Narain Roy		3317

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EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/642,813	ROY, VIPUL NARAIN	
	Examiner	Art Unit	
	Michael Kahelin	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/406,987, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The priority document is lacking support for claims 1-16 because it is lacking: one or more radiological distinct poles, a magnet surrounding a coil, poles covered with gel/PVC-like materials, compatibility with a telemetry wand, and compatibility with an internet/network connection facility.

. Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “magnet surrounding the coil”, “fluoroscopy facility”, “kit for remote programming”, and “large circle coil” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure, including the abstract, is objected to because of numerous informalities. The specification is replete with grammatical errors, of which the Examiner has identified several. For example, in the first paragraph, "at" should be replaced with "the", "with" should be replaced with "of", and "there are" should be replaced with "has". This list is not exhaustive and the entire specification should be proofread and corrected. Additionally, elements in the figures cannot be referred to by color because the figures, as included in the application, are black-and-white.

Appropriate correction is required.

Claim Objections

4. Claims 3 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Because of the phrase "any other shape", these claims place no limitation on the parent claim.

5. Claims 1-16 are objected to because of the following informalities:

6. In regards to claim 1, "a" should be inserted between "having" and "rechargeable" and before "built", "radiological", and "kit".

7. In regards to claims 2, 3, 4, 7, 11, 13, and 14, "/" should be replaced with "or", for instance, "cylindrical, rectangular, squarish, or any other shape".
8. In regards to claim 4, "the" should be inserted before "magnet".
9. In regards to claim 12, "the" should be inserted before "box".
10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-16 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

13. In regards to claim 1, "Vipul's Lifetime Lifeline Permanent Pacemaker..." is vague because this is not an art-recognized term. It is suggested to claim "A pacemaker/cardioverter-defibrillator system comprising:" then list the structural elements of the invention and their structural relationships to each other. A claim cannot be simply a listing of parts. For instance, the battery, generator, radiological distinct pole, kit for remote programming, and coil are all lacking a structural relationship

with each other. Furthermore, "fluoroscopy facility" is vague because it is unclear whether this is some sort of functional limitation of the coil, an additional element, or a location at which the procedure is supposed to take place. Lastly, PPM/ICD box is lacking antecedent basis.

14. In regards to claim 2, the magnet is lacking a structural relationship to the other elements.

15. In regards to claim 6, "the PPM/ICD box" is lacking antecedent basis and it is unclear whether "the large circle" is the same element as the "large radius circular coil". It is suggested to use the same terminology for elements throughout the claims.

16. In regards to claim 8, "the PPM/ICD box" is lacking antecedent basis.

17. In regards to claim 10, "the PPM/ICD box" is lacking antecedent basis.

18. In regards to claim 11, "gel like" and "PVC like" are vague because it is unclear as to what criteria are used to determine likeness to these materials.

19. In regards to claim 12, "a telemetry wand" is inferentially included, rendering it unclear whether this element is part of the claimed invention and "the widely used computer systems" is lacking antecedent basis and vague because it is unclear what these "widely used systems" are.

20. In regards to claims 13, "it" is vague because it is unclear as to what "it" refers.

21. Claim 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-11, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munshi et al. (US 5,411,537, hereinafter "Munshi") in view of Ogden (US 6,070,103, hereinafter "Ogden") and Brownlee et al. (US 4,134,408, hereinafter "Brownlee"). Munshi discloses the essential features of the claimed invention including the following:

24. In regards to claim 1, Munshi discloses a pacemaker (30 and 32) and ICD (62) with a rechargeable battery (col. 7, line 10), a built-in generator (74), kit for remote programming (col. 5, line 66), a coil to supply energy to the built-in generator (72), redundant power supplies (col. 7, line 5) and all elements are inherently radiologically distinct (from the body) because they are housed in a metallic case. Munshi does not disclose including poles with any type of insulation to connect to an outside energy source or that the charging coil is large radius, circular, and movable in multiple planes. Ogden teaches of providing an implantable device with multiple poles with insulation (12) to connect to an outside energy source (Fig. 1) to provide an efficient charging configuration that avoids the drawbacks of inductive charging; and Brownlee teaches of providing a large-radius circular coil (Fig. 3) that is movable in multiple planes (col. 5, line 51) to generate the large-magnitude magnetic fields necessary to charge an internal

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power supply at any desired location on the body. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Munshi's invention by providing a pole to connect to an outside energy source to provide an efficient charging configuration that avoids the drawbacks of inductive charging, a large-radius circular coil to generate the large-magnitude magnetic fields necessary to charge an internal power supply at any desired location on the body.

25. In regards to claim 2, the generator has a magnet (col. 10, line 25).

26. In regards to claim 3, the magnet is inherently some kind of shape.

27. In regards to claim 4, the magnet is surrounded by a coil (col. 10, line 25).

28. In regards to claim 5, the modified invention of Munshi discloses the claimed invention but does not disclose expressly that the magnet surrounds the coil. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the coil arrangement as taught by Munshi with the magnet surrounding the coil because applicant has not disclosed that this configuration provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally, or less, well with the coil configuration as taught by Munshi because both configuration would modify the magnetic flux through the coil, thus modifying its inductive properties. Therefore, it would have been an obvious matter of design choice to modify Munshi's coil configuration to obtain the invention as specified in the claims.

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29. In regards to claim 6, the pacemaker/ICD inherently has radiological markers because the device comprises metallic components, having a different permeability to radiation than the surrounding tissue.

30. In regards to claim 7, the coil is inherently some sort of shape.

31. In regards to claim 8, "fluoroscopy facility" is not an art-recognized term.

Examiner is interpreting this to be "a fluoroscope". Munshi discloses the essential features of the claimed invention except for a fluoroscope. It is well known in the art to locate implants with fluoroscopes to allow a physician to see the location of an implant in a non-invasive manner. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified invention of Munshi with a fluoroscope to allow a physician to see the location of an implant in a non-invasive manner.

32. In regards to claim 13, the programming software is inherently on some type of storing device.

33. Claims 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munshi in view of Ogden and Brownlee as applied to claim 1 above, and further in view of Alt et al. (US 5,725,559, hereinafter "Alt"). The modified invention of Munshi discloses the essential features of the claimed invention except for a device that is compatible with a wand, internet/network connection facility, and remote programming facility. Alt teaches of providing an implantable device with compatibility with a wand (col. 6, line 32) to allow the implant to be programmed with a hand-held device, easily placed over the implant; and compatibility with an internet connection

facility and a remote programming facility (i.e. the device manufacturer) (col. 4, line 52) to allow a very fast and easy upgrade of the implant. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Munshi's invention by providing an implantable device with compatibility with a wand to allow the implant to be programmed with a hand-held device, easily placed over the implant; and compatibility with an internet connection facility and a remote programming facility to allow a very fast and easy upgrade of the implant.

34. In regards to claim 16, the modified invention of Munshi is substantially as described.

Conclusion

35. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents

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located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWK

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4/18/06

GE
GEORGE R. EVANISKO
PRIMARY EXAMINER

4/20/06